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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,324	02/10/2005	Vaughn V. Barnes	100447.0013US	6939

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EXAMINER
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BELLINGER, JASON R

ART UNIT	PAPER NUMBER
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3617

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/524,324

Applicant(s)

BARNES, VAUGHN V.

Examiner

Jason R. Bellinger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 February 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/10/05</u> .   | 6) <input type="checkbox"/> Other: ____.                                    |

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the wheel shield and solid portion of the wheel web forming at least one cavity, at least one ventilation opening formed between the wheel and wheel shield between the cavity and an opening in the wheel web, as set forth in claim 7, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency.

Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to because Figures 6-12 are photocopies of actual photographs. These drawing figures are of poor quality, and do not clearly show the features of the invention.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency.

Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

3. The abstract of the disclosure is objected to because a copy of the front page of the PCT international application is not a proper abstract. Correction is required. See MPEP § 608.01(b).

***Claim Objections***

4. Claim 7 is objected to because of the following informalities: A comma (,) should be inserted after the phrase "by the shield" in line 4 of the claim for clarity. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 3-5 and 7-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 3 is indefinite due to the fact that it is unclear what is actually being claimed by the statement that the center opening is adapted to "prevent the shield from being sandwiched between a wheel and a hub when mounted to a vehicle". Given the fact that the shield is mounted between the wheel and wheel hub of a vehicle, the shield can be considered to be "sandwiched" therebetween. It is thus unclear what is actually being claimed.

Claim 3 is further indefinite due to the fact that the phrase "a wheel" is a double recitation. This limitation has been previously set forth in claim 1. Therefore, it is unclear whether the wheel of claim 3 is the same as that set forth in claim 1, or an additional element of the invention.

Claims 4-5 are indefinite due to the fact that it is unclear what element of the invention is being referred to by the term "it" in line 3 of each claim. Furthermore, the phrase "a wheel" in line 2 of both claims is triple and quadruple recitations, respectively. This limitation has been previously set forth in the claims. Therefore, it is unclear whether the wheel(s) of claims 4-5 is the same as that set previously forth in the claims, or an additional element of the invention.

Claim 8 is indefinite due to the fact that the phrase "an inboard surface" is a double recitation. This limitation has been previously set forth in claim 1. Therefore, it is unclear whether the inboard surface set forth in claim 8 is the same as that set forth in claim 1, or an additional element of the invention. Furthermore, the phrase "a wheel" in line 3 of claim 8 is a quintuple recitation. This limitation has been previously set forth in the claims. Therefore, it is unclear whether the wheel of claim 8 is the same as that previously set forth in the claims, or an additional element of the invention.

7. Claims 4-5 recite the limitation "the web" in line 2 of each claim. There is insufficient antecedent basis for this limitation in the claims. This limitation has not been previously set forth in the claims.

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8. Claim 7 recites the limitation "the solid portion" in line 4. There is insufficient antecedent basis for this limitation in the claim. No structure for the web of the wheel has been previously set forth in the claims.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1 and 3-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Bennick. As best understood, Bennick shows a wheel shield 10 having a curved outboard surface that is adapted to conform to an inboard surface 56 of a wheel 50.

While Bennick does not explicitly state that the outboard surface of the shield 10 has a textured surface, it is inherent that the outer surface would be textured, be it a smooth texture, etc. The shield 10 includes a center opening 22 adapted to prevent the shield 10 from being sandwiched between a wheel 50 and hub when mounted on a vehicle. The shield 10 also includes a plurality of holes 24 positioned adjacent to the web 54 of a wheel 50 when the shield 10 is mounted to a vehicle, thus being adjacent to the wheel 50.

The wheel shield 10 is fastened directly to the wheel 50 by bolts or screws passing through the plurality of hole 24 and into the web 54 of the wheel 50. The wheel 50 includes a web 54 with a plurality of holes (see Figure 2) passing therethrough, the

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web 54 being curved between the holes. The wheel shield 10 is positioned adjacent to the wheel 50 so that the wheel shield 10 blocks the holes in the web 54, the shield 10 and the solid portion of the web 54 forming at least one cavity, and at least one ventilation opening formed between the wheel 50 and wheel shield 10 between the cavity and an opening in the web 54.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennick in view of Bennett. Bennick does not show the outboard surface of the wheel shield having a plurality of ridges. Bennett teaches the use of a wheel shield 10 having a textured outboard surface having a plurality of ridges (see step 38 of Figure 4, and column 3, lines 44-51).

Therefore one of ordinary skill in the art at the time of the invention would have found it obvious to provide a plurality of ridges on the textured surface of the wheel shield of Bennick for the purpose of increasing the aesthetic appearance of the wheel shield and increase the cooling rate of the wheel shield by increasing the surface area of the shield.



Bennick as modified by Bennett does not specify a method of forming a wheel shield using a hydraulic press to cause a sheet of doubly corrugated material to conform to the shape of the inboard surface of a wheel. However it would have been obvious to one of ordinary skill in the art at the time of the invention to use a hydraulic press to form the wheel shield to the contour of a wheel as a substitute process for the roll forming method as taught by Bennett, dependent upon the equipment available during the manufacturing process and cost.

### ***Conclusion***

**13.** The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references are considered to show wheel shield that mount to the rear surface of a wheel. For example, Dean shows a wheel shield of the type described above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason R. Bellinger whose telephone number is 571-272-6680. The examiner can normally be reached on Mon - Thurs (9:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Morano can be reached on 571-272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jason R Bellinger  
Examiner  
Art Unit 3617

**JASON R. BELLINGER**  
**PATENT EXAMINER**

jrb

*MB*  
*9/16/05*